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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
LEWIS, RALPH A				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
01/20/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/769,741

**Applicant(s)**

LAKIN ET AL.

**Examiner**

Ralph A. Lewis

**Art Unit**

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-20, 22-37 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-20, 22-37 and 44-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

**Rejections based on 35 U.S.C. 112, first paragraph**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claims 2 and 23, line 4, there is no reasonable disclosure that the named elements in the group can be used in combination with one another.

**Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-20, 22-32, 44, 45 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 4-20, 22-32, 44, 45 and 47 are confusing in that they indicate that the polished concave bearing surface is configured to directly engage an articulating surface of the femoral component and then are further limited to positively require a

second prosthetic component between the polished concave bearing surface and an articulating surface of a femoral component. The claims confusingly suggest/imply/require that the contradictory relationships occur simultaneously. The polished surface is not capable of directly engaging the articulating surface of a femoral component because the second prosthetic is positively required to be between the polished surface and the femoral component.

In claims 2 and 23, line 4, it is unclear to this examiner how any of the claimed group of elements are usable together as a combination.

In claims 9-20 and 25, the disclosed constraining ring 56 is not capable of being positioned between the polished bearing surface and the articulating surface of a femoral component as required by parent claim 1.

In claim 32, parent claim 27 already requires the second prosthetic to have been implanted – the “coupling” step makes no sense.

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

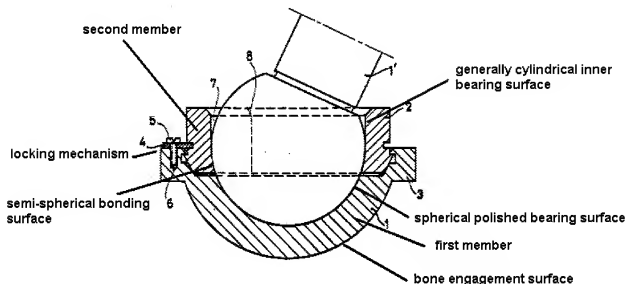
Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Draenert (US 6,682,566).

Draenert discloses a first prosthetic 10 having an internal bearing surface 13 and a locking mechanism (undulations column 3, lines 1-2) that is implanted (column 3, lines 58-62). A trial insert 100 is installed (column 3, line 65). A femoral prosthetic is inserted within the socket of the trial insert 100 and first prosthetic 10 and the rotation of the femur and socket are carefully checked (column 4, lines 6-10). After checking the trial insert 100 is removed (and consequently the femoral prosthetic) and a titanium/ceramic module 20/30 (i.e. the claimed "second prosthetic") is coupled to the first prosthetic (column 4, lines 10-12) and the femoral prosthetic inserted within the socket formed by the first 10 and second 20/30 prosthetic wherein the second prosthetic is between the first and the femoral prosthetic.

Claims 34-36 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated Mullers (US 5,133,763).

Mullers in Figure 1 reproduced below discloses an acetabular implant having a first member 1 having an outer bone engagement surface and an integral inner spherical polished bearing surface for interfacing with the ball of femoral implant 1'. The first member includes a locking mechanism 4. Mullers further discloses a second member 2 coupled to the first member which defines a partial spherical bearing surface adjacent the spherical surface of first member 1 and a cylindrical bearing surface that allows for gap 7. The Mullers first and second members allow for rotational and

translational movement of the femoral implant 1'. In regard to claim 46 note alignment notches column 5, lines 20-25.



The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullers (US 5,133,763).

In regard to claim 34, to the limited extent that Muller does not explicitly state that the inner spherical bearing surface is polished, then one of ordinary skill in the art would have readily recognized such a surface to be polished in order to reduce wear. In

regard to claim 37, Mullers does not give specific dimensions for the length of the illustrated cylindrical bearing surface, however, one of ordinary skill in the art would have found the selection of a length within the range claimed obvious as a matter of routine practice.

#### **Allowable Subject Matter**

Claims 1, 2, 4-20, 22-32, 44, 45 and 47 would be allowable if amended to overcome the 35 U.S.C. 112 rejections above.

#### **Action Made Final**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis  
January 18, 2010

/Ralph A. Lewis/  
Primary Examiner, Art Unit 3732